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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,817	02/22/2002	Takashi Nakabayashi	033035.088	5522

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EXAMINER

NGUYEN, TUAN M

ART UNIT

PAPER NUMBER

2828

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/079,817

Applicant(s)

NAKABAYASHI ET AL.

Examiner

Tuan M Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.



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**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding to claim 1, claim recites a light-generating module comprising a semiconductor light-emitting device, a monitoring light-receiving element, a driving element and a housing. The claim fails to provide any means; any structural related or connected of the plurality elements, which render the claim confusing, vague and indefinite.

Regarding to claim 2, claim recites a first mounting member having first/second and third regions arranged sequentially in a direction for a predetermined axis. Claim also recites monitoring light receiving element has a light detecting region for detecting light without the recitation of any means for defining a first/ second and third region, which render the claim confusing, vague and indefinite.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-5 and 8-14 are rejected under 35 U.S.C. 102(a) as being anticipated by Kato et al ('419) or JP 2000-080694/273514.

With respect to claim 1, Kato et al discloses a light emitting module comprising a semiconductor light emitting device (16), first/second photodetectors (20) consider as the monitoring light receiving element, an etalon (18), collimating means (21) like a lens and housing (12) includes mount members (24, 26, 28, 30), note col. 1 line 16 to col. 8 line 67, see figs. 1-2.

With respect to claims 2-3 and 12, Kato et al discloses a light emitting module (1a) comprising the mounting members (24, 26, 28, 30) having first/ second and third regions arranged sequentially in a direction of a predetermined axis (46), semiconductor light emitting device (16), monitoring light receiving element (20), an etalon (18) and collimating lens (21), note col. 1 line 17 to col. 22 line 57, see figs. 1-9c.

With respect to claims 4 and 8, Kato et al discloses a light emitting module comprising a housing (12) having a plurality of side walls, monitoring light receiving element (20), a substrate (50), note col. 8, see figs. 1-3.

With respect to claim 5, Kato et al discloses the transmission lines are provided on a surface of the substrate, said surface being made off AlN material, note cols. 7-8, see figs. 1-3.

With respect to claims 9-11, Kato et al discloses a light emitting module comprising an optical fiber (14) having an end couple optically to the semiconductor light emitting device (16) said optical fiber being provided in a direction of said predetermined axis and optical module, note col. 7 line 27 to col. 14 line 4, see figs. 1-9c.

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With respect to claims 13-14, Kato et al discloses semiconductor light-emitting device (16) has a pair of end surface (16a, 16b), a monitoring light-receiving element (20) has a light detection region for detecting light, optical fiber (14), see figs 1-8a.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al ('419) or JP 2000-080694/273514 in view of Hauer et al ('641).

With respect to claims 6-7, Kato et al discloses all limitations as set for in claim 4 except for the transmission lines includes microstrip lines and coplanar lines. Whereas Hauer et al discloses microstrip lines and coplanar lines, note col. 1 line 15 to col. 2 lines 27. For the benefit of high frequency semiconductor laser module, it would have been obvious to one having

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ordinary skill in the art at the time the invention was made to provide Kato with the microstrip lines and coplanar lines as taught or suggested by Hauer.

6. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al ('419) or JP 2000-080694/273514 in view of Ichino et al ('724).

With respect to claims 15-18, Kato discloses all limitations as set for in claim 1 except for substrate has wirings, said wirings being connected electrically to said driving element. Whereas Ichino et al disclose substrate has a wirings, said wirings being connected electrically to driving element, note cols. 3-4, see figs. 2a-2b. For the advantageous of light emitting device and light emitting circuit system unit, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Kato with the wirings as taught or suggested by Ichino et al.

With respect to claims 19-20, Ichino et al discloses a substrate has a pair of wirings of transmitting differential modulation signals to driving element and the substrate has a pair of sides, one side being opposed to the other side, note col. 1 line 30 to col. 5 line 10, see figs 1-8.

#### **Citation Of The Pertinent References**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The patent to Kato et al (US patent 6,273,620) discloses semiconductor light emitting module.

The patent to Ichino et al (US patent 6,071,016) discloses light receiving module for optical communication and light receiving unit thereof.

The patent to Miyazaki et al (US patent 6,021,149) discloses optical semiconductor module.

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The patent to Aoki (US patent 5,845,031) discloses optical module having an improved heat dissipation and reduced mechanical distortion.

The patent to Tanaka et al (US patent 5,291,054) discloses light receiving module for converting light signal to electric signal.


***Communication Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan M Nguyen whose telephone number is (703) 306-0247.

The examiner can normally be reached on 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3329.

  
Paul Ip  
SPE  
Art unit 2828

TMN  
January 11, 2003